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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,321	07/23/2001	Kenichi Myokan	0941.65715	3590

7590 12/11/2003

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EXAMINER

MILLER, BRIAN E

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 12/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/911,321

Applicant(s)

MYOKAN ET AL.

Examiner

Brian E. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Claims 1-19 are pending.

Election/Restrictions

1. Applicant's election without traverse of Species (1), claims 1-7, 11-16, in Paper No. 7 is acknowledged. Claims 8-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

1-3
2. Claims 1, 5-7, 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Genheimer (U.S. Pat. No. 5,801,899). As per claims 1, 11 & 17, Genheimer shows in FIGs. 3-5, a disk unit for reading information from or writing information to a disk 18 by means (the transducer) of a head 28 supported by an actuator 20, the disk 18 and the actuator 20 being contained in a housing 10 of the disk unit, the disk unit comprising a shroud (first member) 46 (see col. 5, lines 49-56) having a face perpendicular to a surface of the disk 18 and opposing a peripheral edge of the disk, a spoiler (second member) 100B having a given height in a direction perpendicular to the surface of the disk and extending above the surface of the disk from the peripheral edge and generally toward a center of the disk (element 102A in FIG. 3); (as per claims 2-3, 12-13, 18) wherein the shroud and spoiler are respectively positioned in a counter-rotational direction to the disk; (as per claims ⁵~~X~~ & 14) the shroud 46 is spaced from the end of the

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spoiler (shown in FIG. 4) which space would encompass at least less than 5mm; (as per claim 5) Genheimer shows in Fig. 5 a disk unit wherein the shroud 46 and the spoiler 100 are formed integrally with each other; (as per claim 6) Genheimer shows a disk unit wherein the face of the shroud is curved along the peripheral edge of the disk; (as per claim 7) Genheimer shows the face of the shroud being flat.

Claim Rejections - 35 USC § 103

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Genheimer.

For a description of Genheimer, see the rejection, *supra*. With respect to the spacing of 5mm or less between the one end of the spoiler and shroud, although not expressly set forth in Genheimer, it would have been considered obvious to one having ordinary skill in the art at the time the invention was made to have provided the aforementioned distance, absent any showing of criticality, or any unobvious or unexpected results, would have been considered to be within the level of ordinary skill in the art, at least through routine engineering optimization and/or experimentation, depending on the preferred airflow amount. Additionally, the law is replete with cases in which the mere difference between the claimed invention and the prior art is some range, variable or other dimensional limitation within the claims, patentability cannot be found. It furthermore has been held in such a situation, the applicant must show that the particular range is critical, generally by showing that the claimed range achieves unexpected results relative to the prior art range(s); see *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Moreover, the instant disclosure does not set forth evidence ascribing unexpected results due to the claimed dimensions; see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed.

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Cir. 1984), which held that the dimensional limitations failed to point out a feature which performed and operated any differently from the prior art.

Response to Arguments

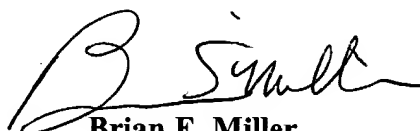
4. Applicant's arguments filed 6/16/03 have been fully considered but they are moot in view of the new grounds of rejection with respect to Genheimer as discussed above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Miller whose telephone number is (703) 308-2850. The examiner can normally be reached on M-TH 7:15am-4:45pm (and every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.



**Brian E. Miller
Primary Examiner
Art Unit 2652**

Bem
December 3, 2003